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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,794	10/18/2005	Yoshiharu Dewa	279606US6XPCT	6105
22850 7590 09/08/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HUSSAIN, IMAD	
			ART UNIT 2451	PAPER NUMBER
			NOTIFICATION DATE 09/08/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/553,794	DEWA ET AL.	
	Examiner	Art Unit	
	IMAD HUSSAIN	2451	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-7,9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-7,9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09 February 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 24 June 2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

***.

2. Claims 2, 3, 5-7, 9 and 11 are pending in Application 10/553794.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 2, 3, 5-7, 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims state the limitation of “without receiving a user input selecting streaming or downloaded file as the method of content delivery”. However, the step of “inputting specifying information specifying the set of content... to be delivered” implicitly requires a selection of streaming or downloaded file as the method of content delivery, as one set of content is to be delivered by streaming and one set of content is to be delivered by downloaded file – if the user chooses content from the former set, the user is implicitly selecting streaming, whereas if the user chooses content from the latter set, the user is implicitly selecting downloaded file.

For purposes of examination, the limitation “without receiving a user input selecting streaming or downloaded file as the method of content delivery” will be read as “without receiving an additional user input selecting streaming or downloaded file as the method of content delivery”.

The claims state the limitation that the “startup file correspond[s] to a license of the specified set of content”. It is unclear what such a relationship entails. The limitation could be interpreted as having a startup file and a license file linked in a database, having a startup file contain actual licensing information (or a link to such), or merely

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having a startup file and a license extent without any explicit connection between the two.

For purposes of examination, the limitation will be read as having both a startup file and a license extent.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 2 and 6 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions.**

A 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

7. Claim 3, 9 and 11 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In this case, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material per se (see Warmerdam, 33 F.3d at 1360 USPQ2d at 1759), falling under the "process" category (i.e. inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process means, art, or method, and includes a new or a known process, machine, manufacture, composition of matter or material").

Functional descriptive material: "data structures" representing descriptive material per se or computer program representing computer listing per se (i.e. software per se) when embodied in a computer-readable media are still not statutory because they are not capable of causing functional change in the computer. However, a claimed computer-readable storage medium encoded with a data structure, computer listing or computer program, having defined structural and functional interrelationships between the data structure, computer listing or computer program and the computer software and

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hardware component, which permit the data structure's, listing or program's functionality to be realized, is statutory (see MPEP 2106).

In this case, the claims are drawn to an apparatus comprising solely software components (with a possibly insignificant extra-solution activity of display performed by physical hardware) and are therefore non-statutory.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2, 3, 5-7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Philip R. Wiser et al. (US 6385596 B1, hereinafter *Wiser*).

Regarding claims 2, 6 and 7, Wiser teaches *a content delivery method and computer readable medium for a content delivery system for delivering content from a content delivery apparatus to a content processing apparatus by way of a network* [Wiser: Abstract], *the method comprising:*

presenting a list of a plurality of sets of content including at least a set of content to be delivered by streaming and a set of content to be delivered by downloaded files at a content processing apparatus [Wiser: Figure 8, “preview” content is delivered by streaming whereas “purchase” content is delivered by downloaded files];

inputting specifying information specifying the set of content, from the sets of content on the list, to be delivered to the content processing apparatus from the content delivery apparatus [Wiser: Figure 7A (preview/stream) and Figure 9AA (purchase/download)];

receiving, by the content processing apparatus from the content delivery apparatus, a startup file specifying streaming or downloaded file as a method of content delivery, said startup file corresponding to a license of the specified set of content [Wiser: Figures 7B (streaming) and 9AC (downloaded file) and Page 4 Lines 51-67, “media voucher”];

and automatically acquiring by the content processing apparatus, without receiving a user input selecting streaming or downloaded file as the method of content delivery, the set of content delivered from the content delivery apparatus according to the startup file [Wiser: Figures 7B (streaming) and 9AC (downloaded file)].

Regarding claims 3 and 9, Wiser teaches *a content processing apparatus adapted to receive deliveries of content from a content delivery apparatus by way of a network [Wiser: Abstract], the apparatus comprising:*

a display [“web browser” and “media player”] configured to present a list of a plurality of sets of content including at least a set of content to be delivered by streaming and a set of content to be delivered by downloaded files [Wiser: Figures 8 and 14];

an interface ["web browser" and "media player"] configured to accept input specifying information specifying the set of content to be delivered from the sets of content on the list [Wiser: Figures 8 and 14];

a receiver ["web browser"] configured to receive from the content delivery apparatus a startup file ["media voucher"] specifying streaming or downloaded file as a method of content delivery, said startup file corresponding to a license of the specified set of content [Wiser: Figures 7B (streaming) and 9AC (downloaded file) and Page 4 Lines 51-67, "media voucher"];

and an acquisition unit ["media player"] configured to automatically acquire the set of content delivered from the content delivery apparatus by way of the network without selecting streaming or downloaded file as the method of content delivery according to the startup file [Wiser: Figures 7B (streaming) and 9AC (downloaded file)].

Regarding claims 5 and 11, Wiser teaches that *the startup file further includes information for accessing the sets of content* [Wiser: Page 4 Lines 51-67, "media voucher"].

Double Patenting

10. Applicant is advised that should claim 2 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

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one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMAD HUSSAIN whose telephone number is (571) 270-3628. The examiner can normally be reached on Monday through Friday from 0800 to 1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/I. H./

Imad Hussain

Examiner, Art Unit 2451

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451